

Application No.: 10/541,996
Filing Date: April 10, 2006

REMARKS

Claims 57 and 58 have been amended to correct clerical error. Claim 57 has been further amended by deleting “dimethyl malonate” and “methyl ricinoleate.” Claim 69 has been canceled. Claim 86 has been added. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the present application in view of the amendments and the remarks set forth below.

Discussion of Objection to Claims

Claim 57 has been objected to because of misspelling. The misspelled word “sillyl” has been replaced with “silyl”. Applicants respectfully request withdrawal of the objection. Claim 58 also has been objected to because of misspellings. The misspelled word “crosslinkable sillyl” has been replaced with “crosslinkable silyl”. Applicants respectfully request withdrawal of the objection.

Claim 69 has been objected to because the claim does not further limits the claim 57 which depends from. Claim 69 has been canceled. Applicants respectfully request withdrawal of the objection.

Discussion of Claim Rejections Under 35 U.S.C. § 103

Claim 57-59, 62-64, 77-81, and 83-85 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujita (WO0020498, English equivalent: U.S. Publication Number 2004/0029990). Applicant respectfully submits that pending claims are allowable over Fujita et al., as discussed below.

Discussion of Patentability of Independent Claim 57

Claim 57 recites dimethyl or methyl derivatives of the ester compounds as active component. On the other hand, Fujita does not explicitly disclose the use of the claimed methyl acrylate or methyl methacrylate to prepare vinyl polymer and does not recognize advantages of using them. Fujita also does not disclose the claimed additional compounds selected from the group consisting of dimethyl succinate, dimethyl glutarate, dimethyl adipate, dimethyl sebacate, methyl acetate, methyl propionate, methyl butyrate, methyl valerate, methyl caprylate, methyl

caprate, methyl laurate, methyl myristate, methyl palmitate, methyl stearate, methyl oleate, and coconut fatty acid methyl ester and the effects of using it. In rejecting the claims, the Examiner further asserts that Fujita teaches using methyl acetylricinolate which has close structure similarity to the formally claimed methyl ricinoleate. However, as amended herein, the use of the methyl ricinoleate has been deleted. Thus, the basis of this rejection has been removed.

The Examiner further assert that it would have been obvious to expect similar beneficial results by using butyl oleate, dioctyl adipate, isodecyl succinate, dioctyl sebacate, and dibutyl sebacate, which Fujita teaches, based on similarity between dimethyl derivatives and butyl oleate, dioctyl adipate, isodecyl succinate, dioctyl sebacate, and dibutyl sebacate. However, as set forth in MPEP 2144.09 VII, "A *prima facie* case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)

The data of second Declaration submitted herewith exhibits that the claimed compound in which the claimed methyl ester was used possess unexpectedly advantageous or superior properties, stable curability after storage, as compared to the Comparative Experimental Example 7 and New comparative examples 1-3 in which the same polymer along with DIDP (diisodecyl phthalate), DEA (dibutyl adipate), DBA (Dibutyl adipate), and DOP (dioctyl phthalate) are used respectively. The data in Table 1 of the decoration clearly shows that no deterioration in skinning time with the claimed ester compounds after storage, while 4 to 8.4 times more skinning time with the comparative examples in which longer chain alkyl esters are used. Accordingly, even if the Examiner had properly established a basis for creating a presumption of the obviousness, ample rebuttal evidence has been presented to overcome any such presumption. The Examiner's rejection should be withdrawn.

Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend Claim 57, and further define additional technical features of the present invention. In view of the patentability of Claim 57, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

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Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claim 82 has been rejected under 35 U.S.C. § 103 as being unpatentable over Fujita et al. in view of Inoue et al. (U.S. Patent No. 6,255,392). Applicant respectfully submits that pending claims are allowable over Fujita et al. and Inoue et al., as discussed below.

As discussed above, Claim 57 which Claim 82 depends from, as amended herein, recites dimethyl or methyl derivatives of the ester compounds as active component, and Fujita fails to teach the limitation, and Inoue does not cure the noted deficiency. Thus, the combination of cited references fails to teach those specific features of the subject matter in Claim 57. Accordingly, the cited references would not match with the present claimed invention, even if combined, and will not lead to a prima facie showing of obviousness.

Discussion of Claim Rejections Under 35 U.S.C. § 103

Claim 57-59, 62-65, 77-81, and 83-85 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando (U.S. Patent Number 5,889,124). Applicant respectfully submits that pending claims are allowable over Ando, as discussed below.

Discussion of Patentability of Independent Claim 57

In rejecting the claims, the Examiner asserts Ando teaches use of dimethyl malonate. However, as amended herein, the use of the dimethyl malonate have been deleted. Thus the basis of this rejection has been removed. Applicant respectfully submits Claim 57 is allowable over Fujita.

Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend Claim 57, and further define additional technical features of the present invention. In view of the patentability of Claim 57, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

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Discussion of Patentability of New Claim

New Claim 86 depends from Claim 57. In view of the patentability of Claim 57, Applicants respectfully submit the Claim 1 is patentable over the prior art.

CONCLUSION

In the light of the applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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